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Erin Cowles**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/673,686 Confirmation No. 1295
Applicant : Eldridge et al.
Filed : September 29, 2003
TC/A.U. : 2829
Examiner : Ernest F. Karlsen

Docket No. : P7D7C2-US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TRAVERSING RESTRICTION
REQUIREMENT PURSUANT TO 37 C.F.R. §§ 1.144 1.181

To Whom It May Concern:

Relief Requested:

Under 37 C.F.R. §§ 1.144 and 1.181, Applicants petition the Director to review and withdrawn a restriction imposed in a paper dated September 29, 2005 in the above identified application.

Statement Of Facts:

In a restriction requirement issued September 29, 2005 (hereinafter the "Restriction"), the Examiner divided claims 47-72 in the above identified application into 15 groups and restricted prosecution to one group. Applicants timely traversed the Restriction in an Amendment filed on October 31, 2005. In the Office Auction mailed from the United States Patent and Trademark Office (the "PTO") January 9, 2006, the Examiner made the Restriction final and provided the following in support of the Restriction:

. . . Applicants have not shown that the inventions are not
patentably distinct. For the purpose of discussion take for an

example a more mundane apparatus such as a chair wherein claim 1 calls for a chair with a seat, legs and a back. Claim 2 depends from claim 1 and adds wheels. Claim 3 depends from claim 1 and adds handles attached to the back. Claim 1 is a linking claim that links claim 2 and 3. Claim 2 is not to wheels, it is to seat, back, legs and wheels. Claim 3 is not to handles, it is to a seat, back, legs, and handles. If the apparatus of claim 2 and claim 3 were combined there would be two seats, two backs, two sets of legs, one set of wheels and one set of handles. The above claim 2 would not be anticipated by a reference that showed handled and the above claim 3 would not be anticipated by a reference that showed wheels.

As discussed below, Applicants respectfully assert that the Restriction is unsupportable. Applicants therefore request that the Restriction be withdrawn.

Argument:

The Restriction should be withdrawn for at least three reasons: (1) the Restriction fails to show that the criteria for restriction stated in the Restriction were met; (2) the Restriction fails to show that the inventions are unrelated; and (3) the Restriction fails to establish burden.

A. Criteria For Restriction Stated In The Restriction Not Met

The Restriction stated that "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together **and** they have different modes of operation, different functions or different effects." (Emphasis added) The Restriction thus correctly set forth a two element test: (1) the inventions are not disclosed as capable of use together, and (2) the inventions have different modes of operation, different functions, or different effects. (See MPEP 806.06.) The Restriction did not, however, establish that either element of the test is met for all 15 invention groups identified in the Restriction. Indeed, the only support for the conclusion that the 15 inventions are allegedly unrelated provided in the Restriction was the

statement that "the different inventions are each to a different combination with claim 47 being a subcombination common to all of the combinations." That statement, however, does not establish either that the 15 groups of inventions are incapable of use together or that the 15 groups of inventions have different modes of operation, functions, or effects. In fact, all dependent claims are, by definition, different combinations of the parent claim. If that mere fact were sufficient to support a restriction, then all dependent claims in all patent applications would be restrictable as drawn to independent, unrelated inventions, which is contrary to long standing practice at the PTO.

Because the Restriction thus does not establish that each of the 15 groups of inventions are unusable together and have different modes of operation, different functions, or different effects, the Restriction cannot stand. For this reason alone, the Restriction should be withdrawn.

B. The 15 groups Of inventions Are Not Unrelated

The MPEP makes clear that, to be restricted as drawn to unrelated, independent inventions, inventions must be completely unrelated—that is, entirely unusable together. Two examples given in the MPEP are a shoe and a locomotive bearing, and a process of painting a house and a process of boring a well. (MPEP § 806.04.) The MPEP also states that "[t]his situation . . . is but rarely presented, since persons will seldom file an application containing disclosures of independent things." (MPEP § 808.01.) The inventions of claims 43-72 are not unrelated and are in fact usable together.

For example, claim 52 (group V) states that the means for elevating a temperature recited in claim 47 "is capable of elevating said temperature of said semiconductor devices to at least 125°C." The phrase "at least 125°C" means that the semiconductor devices may be heated to higher temperatures, including possibly 150°C, 175°C, and 200°C. Why is the means of claim 52 not usable with means capable of heating the semiconductor devices to 150°C, 175°C, and 200°C as stated in claims 53-55 (groups VI-VIII)?

As another example, why cannot terminals (claim 49 and group II) be mounted adjacent a printed circuit board (claim 48 and group I)? As yet another example, why cannot the contact structures recited in claim 47 be springs (claim 71 and group XIV) that are elongate (claim 69

and group XII) and free standing (claim 70 and group XIII)? As still another example, why cannot semiconductor devices that are unpackaged dies (claim 72 and group XV) be elevated to at least 125°C (claim 52 and group V), 150°C (claim 53 and group VI), 175°C (claim 54 and group VII), or 200°C (claim 55 and group VIII)? Similar questions could be posed regarding every combination of the 15 groups of invention identified in the Restriction.

Applicants also note that, in an earlier restriction dated August 23, 2004, claims 48-59 were identified as drawn to one invention rather than the nine separate and allegedly unrelated inventions claims 48-59 were classified into in the Restriction. The August 23, 2004 restriction thus undermines the assertion in the Restriction that the 15 groups of inventions are unrelated.

The Restriction requirement should be withdrawn for the additional reason that the 15 groups of inventions identified in the Restriction are not unrelated.

C. The Restriction Did Not Establish Burden

As set forth in the MPEP, every requirement for restriction requires a showing that there "would be a serious burden on the examiner if restriction is not required." (MPEP 808.) As also set forth in the MPEP, "[f]or purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search." (MPEP §§ 803 and 808.02.)

Here, the Restriction does not allege the need for a separate search or that any of the 15 groups of inventions would have a different classification. Moreover, the Examiner has not provided support for the otherwise conclusory statement in the Restriction that "these inventions . . . have acquired a separate status in the art because of their recognized divergent subject matter." In fact, no evidence supports a conclusion that the 15 groups identified in the Restriction have acquired a separate status in the art or are recognized to have divergent subject matter. The Examiner has thus not established any of the three criteria necessary to show the burden element required to impose a restriction requirement.

Applicants note that, as evidenced by the Office Action of December 15, 2004, the Examiner has already searched and examined the groups corresponding to claims 47-59, which undermines any assertion of a serious burden on the Examiner if restriction is not required.

Thus, for the additional reason that the Examiner has not established the burden element necessary to sustain the Restriction, the Restriction should be withdrawn.

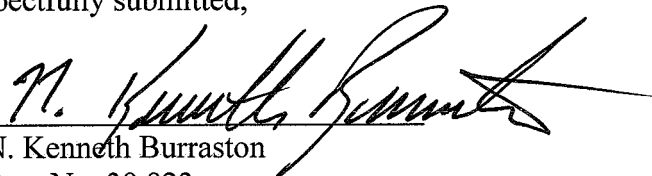
Conslusion:

For all of the above reasons, the Restriction should be withdrawn.

Respectfully submitted,

Date: May 15, 2006

By


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